



03-17-04

Atty. Dkt. No. 061300-0242

#7 D A C

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: O'Connell, et al

Title: ENVIRONMENTAL SHIELD  
FOR A TRUCK MOUNTED  
CONCRETE MIXER

Appl. No.: 09/954,677

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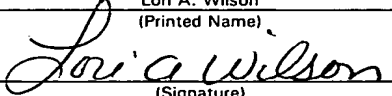
Filing Date: 09/15/2001

MAR 19 2004

Examiner: Sherry D. Brinkley

OFFICE OF PETITIONS

Art Unit:

CERTIFICATE OF EXPRESS MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.	
EV 431598046 US	3/16/04
(Express Mail Label Number)	(Date of Deposit)
Lori A. Wilson (Printed Name)	
 (Signature)	

PETITION PURSUANT TO 37 C.F.R. §1.47(a)Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Applicants hereby petition the Commissioner under 37 C.F.R. §1.47(a) to treat the above-identified patent application as being made by inventor Michael B. Calhoun on behalf of non-signing inventors William J. O'Connell and Jack Harowitz.

Inventor William J. O'Connell refused to sign the Declaration. Inventor Jack Harowitz cannot be located to obtain his signature on the Declaration.

A Statement of Facts signed by the undersigned attorney in support of this petition is provided herewith, and includes the last known home addresses for each of the non-signing inventors, William J. O'Connell and Jack Harowitz.

A check in the amount of \$130.00 is provided herewith in payment of the petition fee pursuant to 37 C.F.R. §1.17(h).

It is requested that the Petition to Revive, filed January 9, 2004, be reconsidered in light of the present Petition and accompanying Statement of Facts filed herewith.

03/18/2004 CHGUYEN 00000032 09954677

01 FC:1460

130.00 OP

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 03-16-04

FOLEY & LARDNER LLP  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5776  
Facsimile: (414) 297-4900

By James A. Wilke

James A. Wilke  
Attorney for Applicant  
Registration No. 34,279



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: O'Connell, et al  
Title: ENVIRONMENTAL SHIELD  
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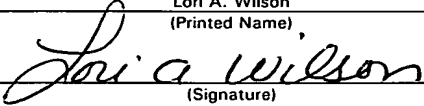
Examiner: Sherry D. Brinkley

Art Unit:

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**MAR 19 2004**

**OFFICE OF PETITIONS**

<b>CERTIFICATE OF EXPRESS MAILING</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.	
EV 431598046 US	3/16/04
(Express Mail Label Number)	(Date of Deposit)
Lori A. Wilson (Printed Name)	
 (Signature)	

**STATEMENT OF FACTS FOR PETITION PURSUANT TO 37 C.F.R. §1.47(a)**

Mail stop: Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

The following is a statement of the facts surrounding the refusal of inventors William J. O'Connell and Jack Harowitz to join in the present application.

1. The present application was filed on September 15, 2001, Serial Number 09/954,677 (hereinafter referred to as "the '677 application").
2. On January 9, 2004, a Petition for Revival of Application was filed for the '677 application (Petition).
3. On January 30, 2004, a Response from the USPTO dismissing the Petition was received stating that the Petition was dismissed since a Petition under 37 C.F.R. §1.47(a) was not included with the Petition.
4. In the Declaration of the undersigned filed with the Petition, in paragraph 9, it was stated that inventor Jack Harowitz was not available and inventor William J. O'Connell is refusing to sign any document.
5. This Declaration supplements the January 9, 2004 Declaration of the undersigned in further support of the Petition under 37 C.F.R. §1.47(a) filed herewith.

6. The undersigned is informed that the last known address of Jack Harowitz is 6331 E. Rochelle Street, Mesa, AZ 85215.

7. The undersigned is informed that the last known address of William J. O'Connell is 5548 Southern Hills Drive, Frisco, TX 75034.

8. The undersigned requested that Oshkosh Truck Corporation obtain the signatures of inventors Calhoun, O'Connell and Harowitz.

9. In response to that request, the signature of inventor Calhoun was obtained. The Declaration with Mr. Calhoun's signature was filed with the Petition. Ms. Cynthia Doughty, an employee of Oshkosh Truck Corporation sent an e-mail to the undersigned describing the attempts to obtain signed documents for the '677 application by the other two named inventors. A copy of the e-mail, dated January 9, 2004, is attached hereto and incorporated herein by this reference.

10. The e-mail states the circumstances of O'Connell's refusal to sign documents relating to the '677 application and the failure to locate Harowitz. To date, Mr. Harowitz has not been located.

11. I hereby declare that all the statements made herein of my own knowledge are true and that all statements made on information believed to be true, and made with, and believe are the knowledge through willful, false statements are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such false statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

Date 03-14-04

FOLEY & LARDNER LLP  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5776  
Facsimile: (414) 297-4900

By James A. Wilke

James A. Wilke  
Attorney for Oshkosh Truck  
Corporation  
Registration No. 34,279

OIP  
MAR 16 2004  
PATENT & TRADEMARK

Wilke, James A.

From: Cynthia Doughty [CDoughty@oshtruck.com]  
Sent: Friday, January 09, 2004 10:15 AM  
To: JWilke@foley.com  
Cc: Brad Bauknecht  
Subject: Patent application - Atty Dkt. 061300-0242

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MAR 19 2004

OFFICE OF PETITIONS

Dear Jim,

As you requested, here is a summary of my attempts to obtain signed documents in connection with the "Environmental Shield for a Truck Mounted Concrete Mixer".

I talked to Bill O'Connell this morning (January 9, 2004). He retired from Trinity due to health reasons in 2000. He has the documents we sent him for execution on December 23, 2003, but is unwilling to sign them. He said he talked to "people" at Trinity and does not want to sign anything that might be in their domain. He said it was an issue of whether he has a right to sign the documents. I asked him if he knew how I might contact Jack Harowitz. He did not.

I then called and talked to Mike Calhoun to see if he could help me locate Jack Harowitz. He does not know his whereabouts. He said that Jack was contracted for a time with Aerotek Contract Engineering Services in Bedford, Texas, but did not know where he is now. He pulled an old business card and gave me a phone number (1-800-329-8290) and said I could try to reach Jason Moore, who was Jack's supervisor when he worked for Aerotek. He had no other suggestions on how to locate him. I have reached nothing but a busy signal in many attempts to call Aerotek. I have tried to obtain a phone number for Mr. Harowitz through directory assistance and several different internet searches, but have been unsuccessful.

I will let you know if I have any success in tracking down Mr. Harowitz before I leave at noon today.

Regards,

Cindy

Cindy Doughty  
LEGAL DEPARTMENT  
OSHKOSH TRUCK CORPORATION  
2307 Oregon Street  
Oshkosh, WI 54902  
920-235-9151 - Ext. 5327  
Fax 920-233-9231

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Attachment to Statement of Facts for Petition Pursuant to 37 C.F.R. §1.47(a)

Application Serial No. 09/954,677

Filed: 9/15/01

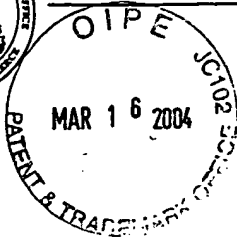


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MAR 19 2004

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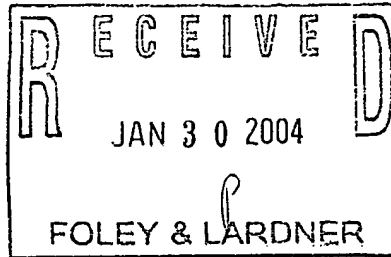


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Page No. 6

James A. Wilke  
FOLEY & LARDNER  
Firststar Center  
777 East Wisconsin Avenue  
Milwaukee WI 53202-5367



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JAN 27 2004

OFFICE OF PETITIONS

In re Application of  
William J. O'Connell, et al.  
Application No. 09/954,677  
Filed: September 15, 2001  
Attorney Docket No. 061300-0242

(LHQ/REVIEWER DECISION)

RESPONSE DUE 3/27/04 ON PETITION

2 WK RMR 3/15/04  
1 MD RMR 2/27/04

This is a decision on the petition under 37 CFR 1.137(b), filed January 9, 2004, to revive the above-identified application.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts (Notice) mailed October 16, 2001. The notice required the statutory basic filing fee, an oath or declaration under 37 CFR 1.63 and the requisite surcharge. Since no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the application became abandoned on December 17, 2001. A Notice of Abandonment was mailed on November 10, 2003. In response, on January 9, 2004, petitioner filed the present petition, the requisite filing fee and surcharge, and a partially executed declaration.

The petition is **DISMISSED**.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (1) above.

The Office acknowledges receipt of the statutory basic filing fee and the \$130.00 surcharge on January 9, 2004. However, petitioner did not submit a properly executed declaration in compliance with 37 CFR 1.63, as required by the Notice mailed October 16, 2001. While the declaration of Attorney James A. Wilke includes a statement that joint inventor Harowitz cannot be contacted and joint inventor O'Connell is refusing to sign, this statement alone is not sufficient for acceptance of a declaration without the signatures of all the joint inventors. Petitioner's attention is directed to 37 CFR 1.47(a) which provides for acceptance of a declaration without the signatures of all the joint inventors.

The above-identified application cannot be revived until a proper declaration under 37 CFR 1.63 is filed or a grantable petition in compliance with 37 CFR 1.47(a) is submitted.

1-30-04  
1/30/04

Application No. 09/954,677

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)", and the missing items noted above. Petitioner is advised that this is not a final agency decision.

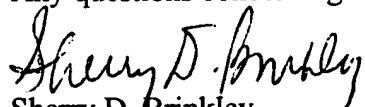
Further correspondence with respect to this matter should be addressed as follows:

**By Mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**By Hand:** 2011 South Clark Place  
Crystal Plaza Two, Lobby  
Room 1B03  
Arlington, VA 22202

**The centralized facsimile number is (703) 872-9306.**

Any questions concerning this matter may be directed to the undersigned at (703) 305-9220.



Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy